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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,769	10/13/2000	Steven A. Weiss	28265-PA	1069

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EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 01/26/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/687,769

Applicant(s)

WEISS, STEVEN A.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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### ***DETAILED ACTION***

#### ***Claim Rejections - 35 USC § 103***

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Eggleston*, U.S. Patent 6,061,660 (May 2001) in view of Kim Pryor, *Virtual Value, How to find dynamite deals on the Internet*, Casino Player, vol. 9, no. 10, (May 1998) <<http://www.casinoplayer.com/archive/9806cp/cpbody.html>> (hereinafter "*Pryor*").

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Eggleston* in view of *Pryor*, as applied to claims 1-14 above, in further view of Kelly et al., U.S. Patent 6,015,344 (Jan. 18, 2000).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

#### ***Response to Arguments***

Applicant's arguments filed Nov. 14, 200 have been fully considered but they are not persuasive.

The applicant argues that the present invention distinguishes over the prior art because the information available in the claimed invention is real-time information. The examiner respectfully disagrees. The feature of real-time information is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hence, the argument is unpersuasive. In addition, the examiner does not interpret "information on potential awards" or "procedures correlating to specific gaming devices" as real-time information.

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Furthermore, the applicant argues that claims 1-15 are distinguished from the prior art because neither *Eggleston* nor *Pryor* disclose gaming establishments or wagering propositions. This argument is essentially admits that the basic features of the claimed invention are known, but asserts that one in the ordinary skill in the art would not find the motivation to apply these known features in a gaming system. The examiner disagrees. One cannot cordon off an invention from general and analogous knowledge simply by limiting it to the practice of gaming. The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).

In this case, *Eggleston* discloses an on-line system allowing businesses to offer incentive games to patrons over Internet websites to motivate them to obtain information and visit the business establishments. *See col. 1:20-46*. It describes improved incentive programs over the Internet whereby consumers may easily access incentive award programs through using their personal computers. *See col. 5:55-6:30*. In particular, *Eggleston* discloses posting information about a plurality of gaming devices on a wide area network (*figs. 8, 9 and col. 13:42-50*); posting on the WAN information about potential promotions, contests and awards (*figs. 8, 9 and cols. 12:21-13:5*); displaying procedures correlating game device use to attain awards, promotions and contests through wagering. (*figs. 8, 9 and cols. 12:21-13:5*) and allowing a prospective player access from a remote location to search as a function of game type, award kind or individual player status (*col. 12:38-61, 16:25-35, 16:46-56*).

*Pryor* discloses that most casinos have websites on the Internet that highlight all their gaming amenities. *See p. 3*. Casinos offer special rates and promotions exclusively to Internet users. *See id.* Additionally, many casinos offer coupons and other discounts over their websites. Furthermore, users can

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register for comp programs over the Internet. *See id.* Finally, *Pryor* suggests that casinos plan to expand their websites to communicate information about promotions to regular customers. *See id.* Hence, using the Internet, casinos provide customers with a valuable tool for planning a trip to a casino. *See id.*

It would be within ordinary skill of an artisan that information is commonly assembled in centralized locations where individuals can search for the information for specific topics (e.g. libraries). Likewise, it would be known to an artisan that businesses commonly assemble information in centralized locations to allow patrons to search the information for specific products/services available at the site of the business in exchange for consideration (e.g. catalogs). Furthermore, an artisan would know that businesses post such information on wide area networks so that remotely located patrons can search the information for specific products/services available at the site of the business in exchange for consideration. (See e.g. [www.llbean.com](http://www.llbean.com).) Such systems were commonplace at the time of the invention and would certainly have been within the ordinary knowledge of an artisan. In specific regard to the claimed invention, an artisan would understand that a casino is a type of business whose products/services are gaming devices and services, and whose consideration is a wager. Consequently, it was within the ordinary skill of a gaming artisan to post information about specific gaming devices/services for patrons to access over wide area networks so that remotely located patrons can search the information for specific devices/services available at the casino in exchange for a wager.

Consequently, when taken as a whole, the prior art collectively suggests to an artisan at the time of the invention to post information about specific gaming devices/services for patrons to access over wide area networks so that remotely located patrons can search the information for specific devices/services available at the casino wherein the information deals with wagering propositions. As suggested by *Eggleston* the system would motivate players to obtain information about a business and visit the business establishment. *See col. 1:20-46.*

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Regarding claim 6, the applicant argues further that the prior art does not disclose the features of posting new games. The examiner respectfully disagrees. *Eggleston* discloses the a business can generates a new incentive program, customizes it, and installs it on the business's website. *See col. 14:26-15:15*. The incentive program may be a game. *See col. 13:42-48*. Hence, *Eggleston* discloses posting new games.

Regarding claim 8, the applicant argues further that the prior art does not disclose a gaming machine. This is discussed above with regard to claim 1. *See supra*. The applicant's assertion that there is no equivalence between the game disclosed in *Eggleston* and gaming machines is unsupported. An therefore unpersuasive. In response, the examiner maintains that a computer executing a program for a scratch-and-win game as disclosed in *Eggleston* constitutes a game machine which only differs from a wagering game in that a player is not required to post a stake. One of ordinary skill in the art would understand the differences between *Eggleston*'s incentive games and a wagering game. In general, incentive games are a subclass of games of chance which do not require a stake. An artisan would possess the knowledge scratch-and-win gaming devices analogous to *Eggleston* that require players to post a stake. Hence, in view of *Eggleston*, when taken as a whole, the prior art collectively suggest to a artisan gaming devices which are updated.

Regarding claim 9, the applicant argues further that the prior art does not disclose awards on the network. Instead, *Eggleston* only provides awards at a physical retailer. The examiner disagrees. *Eggleston* issues awards of loyalty points, discounts and coupons over a network *See fig. 19; col. 13:43-67*. These constitute awards on the network. Furthermore, *Eggleston* awards rights to retail merchandise over the network. *See id.* This also satisfies the claimed feature.

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Regarding claim 14, the applicant argues further that the prior art does not disclose digital vouchers. The examiner disagrees. *Eggleston* issues awards of loyalty points, discounts and coupons over a network *See fig. 19; col. 13:43-67*. These constitute digital vouchers.

***Prior Art, Not Relied On***

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

*L.L.Bean Home Page*, <http://web.archive.org/web/20000815054851/http://llbean.com> (Aug. 2000) discloses retail business information posted on the Internet wherein patrons can search the information for specific products which may subsequently be obtained in exchange for monetary consideration at the site of the business establishment. As discussed above, a casino is an analogous business in which the products are gaming devices and the consideration is a wager.

Bell et al., U.S. Patent 6,574,606 B1 (Jun. 3, 2003) discloses an system for marketing products and services over a network.

Scroggie et al., US. Patent 6,185,541 B1 (Feb. 6, 2001) discloses a system for providing incentives to patrons over a computer network. It includes electronic vouchers.

Blad, U.S. Patent App. Pub. 2001/0048374 A1 (Dec. 6, 2001) discloses a network system allowing patrons to view information about specific gaming machines.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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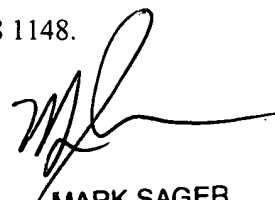
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

s.a.



MARK SAGER  
PRIMARY EXAMINER